

REMARKS

Claims 1-42 are pending in this application. Claims 1, 5, 13, and 37-40 are amended herein. No new matter has been added by the amendments.

I. **Claim Rejections under 35 U.S.C. § 103(a)**

A. **Cotteret in view of Möckli**

The Office rejects claims 1-42 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,735,908 to Cotteret et al. ("Cotteret") in view of WO 95/01772 to Möckli ("Möckli"). Office Action at page 2. Applicant respectfully disagrees and traverses the rejection for the following reasons.

To establish a prima facie case of obviousness, three criteria must be met: (1) there must be some suggestion or motivation to combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references must teach or suggest all the claim limitations. M.P.E.P. § 2143 (8th ed., Rev. 2, 2004). With regard to the suggestion or motivation to combine the reference teachings, the Federal Circuit has stated on numerous occasions that inventions are typically new combinations of existing principles or features. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998).

In *Rouffet*, the Court explained that an examiner may find every element of the claimed invention in the prior art but mere identification of each element in the prior art is not enough to negate patentability. *Id.* at 1357, 47 U.S.P.Q.2d at 1357. Instead, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select

the elements from the cited prior art references for combination in the manner as claimed.” *Id.*, 47 U.S.P.Q.2d at 1458. These reasons to be provided by the Office would satisfy the requirement of showing a suggestion or motivation to combine the reference teachings.

Furthermore, the Office’s basis for the determination of obviousness cannot be what the skilled person might try or find obvious to try. *See In re O’Farrell*, 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). Specifically, the Federal Circuit has identified some situations that exemplify an “obvious to try” rationale. *Id.* For example, an “obvious to try” rationale can be found where one “var[ies] all parameters or tr[ies] each of numerous possible choices until one possibly arrived at a successful result, [because] the prior art gave either no indication of which parameters where critical or no direction as to which of many possible choices is likely to be successful.” *Id.* at 903, 7 U.S.P.Q.2d 1681 (citation omitted). Additionally, “what was ‘obvious to try’ was to explore a general approach that seemed to be a promising field of experimentation, where the prior art gave only guidance as to the particular form of the claimed invention.” *Id.* Thus, prior art proposing a general approach or identifying numerous possible choices does not establish a *prima facie* case of obviousness.

Here, the Office states that Cotteret teaches using cationic or amphoteric substantive polymers in oxidation dye compositions. Office Action at page 2. In addition, the Office contends that Cotteret teaches that direct dyes may be added to the oxidation dyeing compositions. *Id.* The Office relies on Möckli, on the other hand, for teaching specific direct dyes. *Id.* In particular, the Office identifies in Möckli direct dyes

which overlap with those presently claimed. *Id.* It is Cotteret's broad disclosure of direct dyes in an oxidation dye composition and Möckli's disclosure of specific dyes that the Office relies on to suggest a motivation for the combination of these references. Applicant, however, disagrees.

Cotteret is directed to enhancing the selectivity of dyes containing at least one specific oxidation precursor (1-hydroxyalkyl- or 1-hydroxyalkoxy-2,5-diaminobenzene type) by combining them with at least one cationic or amphoteric substantive precursor. Cotteret at Col. 1, II. 50-56. Cotteret also discloses that "in addition to the oxidative dye precursor, . . . the dye compositions *may also* contain other oxidation dye precursors as well as direct dyes . . ." *Id.* at Col. 5, II. 53-57 (emphasis added). Cotteret, however, lacks any specific criteria or guidance for the addition of direct dyes.

Instead, Cotteret merely provides for a broad disclosure of many dyes by stating that "[t]he direct dyes themselves may be chosen from nitro dyes, azo dyes or anthraquinone dyes." *Id.* at Col. 6, II. 5-6. Thus, Cotteret broadly indicates that potentially millions of possible direct dyes could be used to enrich the shades of his oxidation dye compositions. Such a broad disclosure hardly provides the requisite teaching or suggestion required to establish a *prima facie* case of obviousness. See *In re Baird*, 16 F.3d 380, 382, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994) (where no suggestion of variables that would give rise to the selection was found, the reference did not render obvious Applicants' invention).

The Office's reliance on Cotteret's general approach, however, cannot amount to a motivation for combination with Möckli. In moving from the cited prior art to the claimed invention, one cannot base a determination of obviousness on what the skilled person might try or find obvious to try. *See O'Farrell*, 853 F.3d at 903, 7 U.S.P.Q.2d at 1681.

Nevertheless, "a reference must be considered not only for what it expressly teaches, but also what it fairly suggests." *See In re Burckel*, 592 F.2d 1175, 1179, 201 U.S.P.Q. 67, 70 (C.C.P.A. 1979). Möckli lacks a disclosure that "fairly suggests" using its direct dyes in an oxidative composition. *See, e.g.*, Möckli at page 1. Möckli states that "increasing reservations are being voiced about possible topological risks posed not only by the [oxidative dyeing] substances used as starting materials but also by the oxidation intermediate and end products, whose precise composition is virtually uncontrollable." *Id.* Thus, Möckli does not suggest using its dyes in a composition containing oxidation dyes, like Cotteret's, and Cotteret does not suggest using its dyes in a composition lacking an oxidation dye, like Möckli's. For these reasons, there is no suggestion or motivation to combine these cited references and as such, a *prima facie* case of obviousness cannot be established.

In further support of Applicant's position, the Declaration of Christine RONDEAU is submitted herein under 37 C.F.R. § 1.132. The Declaration describes comparative testing between Applicant's invention and comparative Compositions A and B, of which Composition B is relevant with regard to the combination of Cotteret and Möckli. In this comparison, the inventive composition comprises, among other things, at least one

cationic direct dye (Basic Orange 31) with at least one cationic or amphoteric substantive polymer (a polyquaternary ammonium). Comparative Composition B, representative of the teachings in Cotteret, i.e., utilizes a neutral direct dye as opposed to a cationic direct dye exemplified in the inventive composition.

The results of the comparison are shown in the table on page 4 of the Declaration. As demonstrated, the color variation, as measured by a spectrophotometer, for the inventive composition is much less than for the comparative Composition B. In other words, the hair dyed with the inventive composition containing a cationic direct dye exhibits a much less selective color than the hair dyed with comparative Composition B corresponding to Cotteret's disclosure. This result is desirable as a dye with a less selective coloration produces a homogenous color distribution along the keratin fiber. See Applicant's Specification at page 2, II. 9-20.

Cotteret's teaching that the addition of direct dyes can "modify the shades to enrich the shades with glints" suggests any direct dye can yield this beneficial result. However, the discrepancy in color variation between the inventive composition and Composition B clearly demonstrates that Cotteret's suggestion is just a generalized approach for numerous possible choices. Furthermore, this result supports Applicant's position that it would not have been obvious to choose any of the dyes from Cotteret's broad disclosure of "nitro dyes, azo dyes or anthraquinone dyes," i.e., direct dyes and reasonably expect success. Clearly, all dyes do not give the same result.

For at least these reasons, Applicant submits that a prima facie case of obviousness has not been established and thus, Applicant respectfully requests that this rejection be withdrawn.

B. Kao Corp. in view of Möckli

The Office also rejects claims 1-23, 32-36, and 41-42 under 35 U.S.C. § 103(a) as unpatentable over DE 29512302 to Kao Corp. (“Kao”) in view of Möckli. Office Action at page 4. Applicant respectfully disagrees and traverses the rejection for the following reasons.

According to the Office, Kao teaches “compositions for dyeing or toning human hair which comprise a direct dye and a hydroxylalkyl guar gum or a quaternary salt thereof.” Office Action at page 4. The Office, however, admits that “Kao does not teach cationic direct dyes of the claimed formulae.” *Id.* As such, the Office relies on Möckli for the disclosure of the presently claimed at least one cationic dye. *Id.* The Office concludes that it would have been obvious to one of ordinary skill in the art to substitute Möckli’s dyes for those of Kao’s because Möckli’s hair dyes are used for the same purpose as Kao’s and Möckli’s dyes improve the color strength and fastness properties as compared with Kao. *Id.* at page 5.

As noted above, “a reference must be considered not only for what it expressly teaches, but also what it fairly suggests.” *See Burckel*, 592 F.2d at 1179, 201 U.S.P.Q. at 70. As such, Kao discloses compositions for dyeing or toning human hair using direct dyes. Noting that the prior art compositions were not able to achieve a satisfactory level

of stability, Kao discloses a composition achieving improved stability and containing at least one direct dye, preferably cationic, as well as 0.1 to 7.5% by weight of at least one hydroxy-C₂-C₄-alkyl guar gum and/or its quaternary derivatives. Translated Kao at page 1. Thus, Kao suggests improving the stability of dye compositions by using a hydroxy-C₂-C₄-alkyl guar gum together with a dye compatible with that guar gum. Translated Kao at page 2. In addition, Kao provides for the addition of at least one synthetic or natural hair conditioning polymer (e.g., cationic polymers) in combination with the required guar gum or its derivative in the dye composition. Translated Kao at pages 1, 3.

Notably, Kao teaches that the addition of the hydroxyalkyl guar gum derivative dramatically impacts the absorption of the dye and thus, is responsible for the substantially improved color intensity. Translated Kao at page 1. This requirement of a guar gum suggests that its absence will influence the overall color intensity. Under the Office's rationale, a person of ordinary skill in the art is expected to selectively ignore this requirement of the guar gum and merely utilize Kao for the cationic dyes taught on page 2 of the translation and the optional cationic polymers.

Furthermore, Kao lists forty-two direct dyes that have enhanced stability and dye uptake properties with the addition of the guar gum derivative on pages 2-3 of the translation, including nineteen preferred cationic dyes. Those dyes include, for example, Basic Blue 99, Basic Brown 17, Basic Red 76, and Basic Yellow 57. Translated Kao at page 2. Kao, thus, teaches only that these listed basic dyes "are especially enhanced by the addition of the guar gum derivative." Translated Kao at

page 2. However, none of the dyes in this list falls within the scope of the presently claimed cationic direct dyes.

Möckli, the secondary reference, provides no remedy for Kao's deficiencies. Even though Möckli discloses cationic direct dyes that overlap with those presently claimed, this fact is insufficient to serve as motivation for combination with Kao, particularly because Möckli fails to teach or suggest that any of its dyes would be compatible with Kao's guar gums. Kao also fails to suggest that Möckli's dyes would be compatible with its guar gums. Further, Möckli discredits the preferred cationic dyes of Kao; in particular, Basic Blue 99, Basic Brown 16, Basic Brown 17, Basic Red 76, and Basic Yellow 57. Möckli at page 2.

In further support of Applicant's position, the Declaration of Christine RONDEAU is submitted herein under 37 C.F.R. § 1.132. The Declaration describes comparative testing between Applicant's inventive composition and comparative Composition A. In this comparison, the inventive composition comprises, among other things, at least one cationic direct dye (Basic Orange 31) with at least one cationic or amphoteric substantive polymer (a polyquaternary ammonium). Comparative Composition A, representative of the teachings in Kao, however, utilizes the same direct dye (Basic Orange 31) with a quaternized hydroxypropylguar, i.e., hydroxy-C₂-C₄-alkyl guar gum.

The results of the comparison are shown in the table on page 4 of the Declaration. As demonstrated, the color variation, as measured by a spectrophotometer, for the inventive composition is much less than the comparative

Composition A, which contains a guar gum as required by Kao and not present in the inventive composition. Under the Office's rationale, substituting Kao's teaching of specific cationic direct dyes with those taught in Möckli would yield a composition with improved color intensity. This substitution, however, clearly does not yield the homogenous color as achieved by the inventive composition. Instead, the disparate color variations demonstrate the influence the guar gum has on the dye composition and that one of ordinary skill in the art would not have reasonably expected a successful combination.

For at least these reasons, Applicant submits that a prima facie case of obviousness has not been established and thus, Applicant respectfully requests that this rejection be withdrawn.

II. Double Patenting

The Office rejected claims 1-42 under the judicially created doctrine of double patenting over claims 1-34 of U.S. Patent No. 6,592,633. Office Action at page 6. While Applicant disagrees with the merits of the rejection, in order to advance the prosecution of this application, Applicant has filed concurrently herewith a Terminal Disclaimer over U.S. Patent No. 6,592,633. Accordingly, Applicant respectfully submits that this ground for rejection should be withdrawn as moot.

III. Claim Rejections under 35 U.S.C. § 112, second paragraph

The Office also rejects claims 1-42 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the invention. Office Action at page 7.

A. Claim 1

In particular, the Office rejects claim 1 as “indefinite for defining R₁, R₂ and R₆ as ‘optionally oxygenated or nitrogenous heterocyclic.’” Office Action at page 7. Applicant disagrees, but in order to advance prosecution, claim 1 has been amended herein to recite “a heterocycle containing at least one heteroatom chosen from oxygen and nitrogen.” As such, Applicant respectfully submits that this ground for rejection should be withdrawn as moot.

B. Claims 1 and 13

The Office indicates that claims 1 and 13, which contain trademarks to “Polyquaternium 10” and “Polyquaternium 24,” are not proper and do not comply with the requirements of 35 U.S.C. § 112, second paragraph. Office Action at page 7. The presence of a trademark in a claim is not *per se* improper under 35 U.S.C. § 112, second paragraph. M.P.E.P. § 2173.05(u). In order to advance prosecution, however, Applicant has amended claims 1 and 13 to replace the trademarked names with the chemical names of each compound.

Specifically, “Polyquaternium 10” is replaced by the CTFA definition “polymeric quaternary ammonium salts of hydroxyethyl cellulose reacted with a trimethyl ammonium substituted epoxide” and “Polyquaternium 24” is replaced by the CTFA definition “polymeric quaternary ammonium salts of hydroxyethyl cellulose reacted with a lauryl dimethyl ammonium substituted epoxide.” See INTERNATIONAL COSMETIC INGREDIENT DICTIONARY & HANDBOOK (Tara E. Gottschalack & Gerald N. McEwen, Jr., Ph.D., J.D. eds. 10th ed. 2004). Accordingly, Applicant submits that this ground for rejection should be withdrawn as moot.

C. Claims 37 - 40

In addition, the Office rejects claims 37-40 “because a claim cannot define a component in a composition by referring to that component as defined in a previous claim unless that claim further limits the previous claim.” Office Action at page 7. While Applicant does not agree with this rejection, in order to advance prosecution, Applicant has amended claims 37-40 to incorporate the subject matter from claim 1. No new matter has been added by these amendments. Accordingly, Applicant submits that this ground for rejection should be withdrawn as moot.

IV. Final Comment

Applicant’s undersigned representative thanks Examiner Einsmann for issuing the non-final Office Action dated May 26, 2004, allowing Applicant time to prepare and submit comparative test results.

V. **Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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